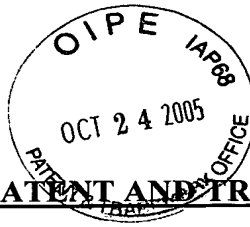


DOCKET NO.: 5244-0117-2XCONT/fbl



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 2142

Tetsuro MOTOYAMA

SERIAL NO: 09/457,669

EXAMINER: PRIETO, BEATRIZ

FILED: December 9, 1999

FOR: METHOD AND SYSTEM FOR DIAGNOSIS AND CONTROL OF
MACHINES USING CONNECTION AND CONNECTIONLESS MODES OF
COMMUNICATION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

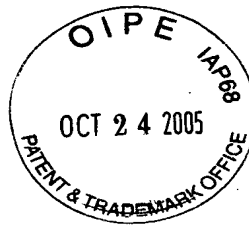
James J. Kulbaski
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Kurt M. Berger, Ph.D.
Registration No. 51,461

JJK:KMB:fbl

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BRADLEY D. LYTLE
REGISTRATION NO. 40,073

DOCKET NO: 5244-0117-2X CONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TETSURO MOTOYAMA : EXAMINER: PRIETO, BEATRIZ
SERIAL NO: 09/457,669 :
FILED: DECEMBER 9, 1999 : GROUP ART UNIT: 2142
FOR: METHOD AND SYSTEM FOR :
DIAGNOSIS AND CONTROL OF
MACHINES USING CONNECTION AND
CONNECTIONLESS MODES OF
COMMUNICATION

REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant respectfully requests that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

Applicant submits that the Office Actions dated February 10, 2005, and July 26, 2005, fail to provide a proper ground for rejection of the claims under 35 U.S.C. § 102(b).

In the outstanding Office Action, Claims 52-54, 57-62, 64, 65, 69, 76-79, 82-87, 89, 90, 94, and 101 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,537,626 to Kraslavsky et al. (hereinafter "the '626 patent"). As set forth in the Request for Reconsideration filed May 10, 2005, this rejection is clearly deficient based on the Board of Patent Appeals and Interferences' appeal decision dated December 23, 2003 ("Board decision") in related Application No. 08/738,659 ("the '659 application").

Independent Claim 52 recites, *inter alia*, a business office device comprising a communications interface within the business office device for transmitting, using an Internet e-mail protocol at an application layer, an e-mail containing a first portion of the status information to the monitoring device, wherein the business office device is selected from the group consisting of a printer, a copier, a scanner, a metering system and a multi-function copier.

As discussed in the Request for Reconsideration filed May 10, 2005, the Board's '659 decision states that

[w]e find no disclosure or suggestion in Kraslavsky or Cohn, nor in any combination of the teachings thereof, for transmitting Internet electronic mail messages between machines, for monitoring devices, as claimed by Appellant.... We thus do not sustain the Section 103 rejection of Claims 12-15, 17-19, 38-41, 43, 44, 52-61, 68-73, 75-77, 79-81, 83-85, and 87.¹

The Board's opinion was directed in part at '659 Claim 68, which depended from independent '659 Claim 10 and recited, *inter alia*, "transmitting information through an Internet electronic mail message over the Internet from the monitoring device to the monitored device." Note that '659 Claim 10 recited transmission of electronic mail, but not transmission of Internet electronic mail. Taking a broad interpretation of the term "electronic mail," the Board proceeded to enter a new ground of rejection of '659 Claim 10 as anticipated by the '626 patent, but did not sustain the rejection of dependent '659 Claim 68. Subsequent to the Board's decision, '659 Claim 10 was amended to recite "transmitting the information through electronic mail...using an Internet e-mail protocol," and to limit the monitored device to a specified list of devices similar to the list recited in present Claim 52. Based on the amendment to '659 Claim 10, that claim was allowed by the Examiner of the '659 application.

¹ '659 Board decision dated December 23, 2005, page 5.

Accordingly, based on the actions of the Board and the subsequent allowance by the '659 Examiner, Applicant amended the claims of the present application to recite limitations analogous to the limitations recited in the allowed '659 application. For example, as discussed above, present Claim 52 recites transmitting, using an Internet e-mail protocol..., an e-mail containing a first portion of the status information to the monitoring device." In this regard, we note that the Board's '659 decision also stated that "[w]e interpret transmission of the *Internet* electronic mail message, as claimed, as requiring more than the electronic message transmission as disclosed by Kraslavsky."² Further, the Board stated that "[h]owever, we agree with Appellant, as developed in the briefs and the declaration, that *the combination of Kraslavsky and Cohn would not have suggested the transmission of Internet electronic communications* between a monitored and a...[monitoring] device as claimed."³

Thus, despite the fact that Claim 52 recites limitations analogous to the limitations recited claims in the allowed '659 application, and despite the Board's clear statements that the '626 patent fails to teach or suggest the transmission of Internet electronic mail messages between a monitored device and a monitoring device, the Examiner maintains that Claim 52 is anticipated by the '626 patent. In support of her rejection, the Examiner points to the '626 patent's general disclosure of "Netware" compatible print services and communications over TCP/IP.⁴ However, Applicant respectfully submits that the Examiner's interpretation of the '626 patent is directly conflicting with the Board's prior interpretation of that reference as set forth in its appeal decision in the related '659 application. In particular, the Board clearly states that the '626 patent does not disclose transmitting Internet electronic messages from a monitored device to a monitoring device.

² Id. at page 4. Emphasis added.

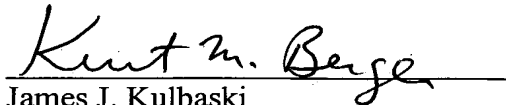
³ Id. at page 5. Emphasis added.

⁴ See pages 6-8 of the Office Action dated July 26, 2005.

Accordingly, based on the clear legal deficiency of the outstanding rejection of the claims, Applicant respectfully requests that prosecution be re-opened and the current grounds of rejection be withdrawn.

Respectfully submitted,

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